

### **Remarks/Arguments**

#### **In the Specification:**

By the previously-filed Amendment and Reply to Office action of Feb. 20, 2004, Paragraphs [0001] and [0027] have been amended to correct minor editorial problems that were pointed out in the Office action and in the first telephone interview with the Examiner. This amendment was not acknowledged in the Office action of June 18, 2004.

#### **Errors in Rejection:**

The assignee respectfully asserts that:

1. It was erroneous to reject Claims 1-5, under 35 U.S.C. 101, as being directed to nonstatutory subject matter. A prima facie case of nonstatutory subject matter has not been established.
2. It was erroneous to reject Claims 1-15, under 35 U.S.C. 103, over King, EP 1,081,916A2, in view of Kroenke, *Database Processing: Fundamentals, Design & Implementation*, Chapter 3, and further in view of Spies, US 5,689,565. A prima facie case of obviousness has not been established.

#### **1. Argument regarding Claims 1-5, 35 U.S.C. 101 and statutory subject matter.**

*"Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101."* MPEP 2106 II. A [Emphasis added].

The Office action of June 18, 2004, on Page 4, states a test, without citing any authority: "For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts." Without conceding that this is an accurate statement, even if this were the proper test, the present patent application passes that test. It is clear that technological arts are involved in rejected Claims 1-5, when these claims are read in light of the specification (e.g. Pages 10-24, or Paragraphs 0035-0090 of the published version, and FIGS. 3-7).

It is also clear that a useful, concrete and tangible result is produced by rejected Claims 1-5, when these claims are read in light of the specification (e.g. Pages 10-24, or Paragraphs 0035-0090 of the published version, and FIGS. 3-7). In the present patent application, the Office cannot show that rejected Claims 1-5 are devoid of any limitation to a practical application. Thus the Office has not satisfied its burden to establish a prima facie case of nonstatutory subject matter.

The Office action at Page 4 appears to assert that method claims need to contain certain physical limitations, naming some "technological apparatus." This is not supported by the MPEP, and is contrary to the court decision of *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999)(cited with approval at MPEP 2106 II. A, and MPEP 2106 IV B 2 (b) ii). Consider Claim 1 in *AT&T*, and note that the method steps do not name any apparatus, as discussed in the previously-filed Amendment and Reply to Office action of Feb. 20, 2004.

**2. Argument regarding 35 U.S.C. 103 and lack of a prima facie case of obviousness:**

**A. Limitations in the Rejected Claims Which Are Not Described in the References Relied On:**

Rejected Claims 1, 6, and 11 involve a privacy agreement. The following language from Claim 1 provides an example:

...expressing each relationship between each pair of said parties in terms of a privacy agreement; ...

wherein:

said privacy agreement uses a limited number of privacy-related actions concerning said personally identifiable information;

said privacy agreement expresses rules regarding said privacy-related actions, for each of said parties; and

said privacy agreement is specific to a single purpose.

See also the description and example of a privacy agreement at Pages 20-23, or Paragraphs 0081-0086 of the published version of the specification.

Nothing like this is found in the references the Office action relies on. Neither Kroenke nor Spies contain the phrase "privacy agreement." Privacy is not a topic treated in the Kroenke chapter that the Office action relies on.

King happens to use the term "privacy agreement" in a narrow sense to mean something automatically "established between ... a client device and a content server," for reporting the location of a cell phone or other wireless device. King,

page 2, lines 50-53; page 4, lines 36-43. King's example "privacy agreement" concerns location and a location-based service (sending a tow truck to the location of a wireless client device). King, page 8, and page 2, lines 39-41. King mainly concerns reporting the location of a cell phone or other wireless device, a focus that is seen in each of King's drawings, Figures 1-10, or their written descriptions (e.g. absolute location object (ALO) in King's Figures 6 and 10, or handset location object (HLO) in King's Figures 8 and 9A).

King's "privacy agreement" clearly does not have the same meaning, and does not have the breadth of utility shown for a privacy agreement in the subject patent application (e.g. specification Pages 20-24, or Paragraphs 0081-0089 of the published version, including an example privacy agreement between a person and a bookstore's subscription department).

**B. Why the References, Taken as a Whole, Do Not Suggest the Claimed Subject Matter:**

The cited references do not suggest a solution involving subject matter of rejected Claims 1, 6, and 11: privacy agreements for example. On the contrary, King teaches away from the claimed subject matter.

Teaching away is the antithesis of suggesting the claimed subject matter. King teaches away, by using the phrase "privacy agreement" in a narrow sense to mean something automatically established between "a wireless client *device* and a server *device*," for reporting the location of a cell phone or other wireless device. King, page 4, lines 36-43 [emphasis added]. Thus King teaches away

from: "expressing each relationship between each pair of said parties in terms of a privacy agreement," where parties may be "natural persons, departments, computer systems, or organizations," for example (language from Claim 1 and Paragraph 0085 in the subject patent application).

King mainly concerns reporting the location of a cell phone or other wireless device, so King teaches away from utilizing a privacy agreement for other purposes, such as a privacy agreement between a subscriber and a bookstore's subscription department (example in Paragraph 0086 in the subject patent application). In an online bookstore, for example, a list of books purchased, together with the information on which subscriber purchased them, would be Personally Identifiable Information involved in a privacy agreement (see description of FIG. 5, Paragraph 0039, in the subject patent application). Other examples involving business, government and medicine are seen in the description of privacy-related actions, utilized by privacy agreements (description of FIG. 6, in Paragraphs 0064-0080 in the subject patent application). King leads away from such broadly useful subject matter, due to King's focus on location.

**C. Rejected Claims 2-5, 7-10, and 12-15 are not separately argued.**

The points made above, concerning Claim 1, also apply to Claims 2-5, which depend upon Claim 1. The points made above, concerning Claim 6, also apply to Claims 7-10, which depend upon Claim 6. The points made above, concerning Claim 11, also apply to Claims 12-15, which depend upon Claim 11. Thus a prima facie case of obviousness has not been established.

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Reply to Office action of June 18, 2004

Assignee respectfully submits that the rejection of Claims 1-15 should be withdrawn, and requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul D. Heydon", with a long horizontal flourish extending to the right.

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